

REMARKS

Applicants have reviewed the Office Action dated June 14, 2006 (hereinafter “Office Action”), and the reference cited therewith.

Claims 10-11 and 29 are currently amended. Claims 14-22 have been previously canceled without prejudice or disclaimer. No claims are added. As a result, claims 1-13 and 23-30 are now pending in this application. Applicants submit that the amendments to the claims are fully supported by the Applicants’ application as originally filed, and no new matter has been added.

Applicants hereby respectfully request further examination and reconsideration of the application in view of the following remarks.

§112 Rejection of the Claims

Claim 10 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention.

Applicants have amended claim 10 to recite “a portion of a base plate,” thereby overcoming the basis of this rejection. Reconsideration and withdrawal of this rejection of claim 10 is respectfully requested.

§102 Rejection of the Claims

Claims 1-13 and 23-26 are rejected under 35 U.S.C. § 102(b) as being anticipated by Capoccia (U.S. Patent No. 3,238,679). Applicants respectfully traverse such rejections and submit that the Office Action has failed to make out a *prima facie* case of anticipation.

To establish a *prima facie* case of anticipation, a single reference which teaches or enables each of the Applicants’ claimed elements (arranged as in the claim) expressly or inherently as interpreted by one of ordinary skill in the art must be provided. (*See W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983)(stating “[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration); *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984)(indicating “[i]n deciding the issue of

anticipation, the trier of fact must identify the elements of the claims, determine their meaning in light of the specification and prosecution history, and identify corresponding elements disclosed in the allegedly anticipating reference”); and *Scripps Clinic & Research Found. V. Genentech Inc.*, 927 F.2d 1565, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)(adding “[t]here must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention”).

“If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent.” *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992).

Claims 27-30:

As an initial note, Applicants’ submit that claims 27-30 do not appear to have been examined. (*See* Office Action, pages 1-2). To this end, Applicants respectfully request examination and consideration of claims 27-30.

Claims 1-7:

Applicants submit that not all of the elements and/or limitations of claims 1-7 can be found in the cited reference (Capoccia), as required by *W.L. Gore & Associates*, and further submit that the Office Action has failed to identify corresponding claim elements in Capoccia, as required by *Lindemann Maschinenfabrik GmbH*.

Claim 1:

Applicants cannot find (and the Office Action has failed to identify) in Capoccia, “a double hung window including a window sash movably disposed within a window jamb assembly,” as recited in claim 1. Rather, Capoccia recites “[a] window 14 is disposed in the opening and supported in fixed relationship thereto by fastening a rigid peripheral frame 15 thereof to the studs10 and horizontal frame members[:]) [t]he window 14 illustrated is of the fixed or non-opening type.” (Column 2, lines 34-38).

Applicants further cannot find (and the Office Action has further failed to identify) in Capoccia, “a bracket assembly including a bracket portion having at least a first portion and a

second position, the bracket assembly disposed within the window jamb assembly when the bracket portion is disposed in the first position, the bracket portion disposed over a portion of the interior portion of the sash when the bracket portion is disposed in the second position,” as further recited in claim 1. Rather, the Office Action merely identified the corner clip 32 of Capoccia as comprising the claimed bracket assembly and went on to unidentifiably assert that such corner clip 32 meets the additional bracket elements and/or limitations of Applicants’ claim 1 (i.e., the bracket assembly includes a bracket portion having at least a first position and a second position, the bracket assembly being disposed within the window jamb assembly when the bracket portion is disposed in the first position, the bracket portion being disposed over a portion of the interior portion of the sash when the bracket portion is disposed in the second position).

Among other things, Applicants cannot find in Capoccia (1) a movable portion of the corner clip 32 as having at least a first position and a second position nor (2) a window jamb assembly into which the corner clip may be disposed when the movable portion is in the first position. Capoccia recites “the clip 32 comprises a right angle member formed with orthogonally disposed flanges 33 and 34[;] [e]xtending along one edge of the flange 33 and integrally formed therewith is an enlarged cylindrical section or bead 35 . . . [i]nallation is a simple operation requiring only that the clips 32 be positioned adjacent their respective corners and the beads pressed or forced into the channel-form interiors of their respective flexible web portions 29 until seated therein.” (Column 5, lines 2-6 and 22-26). Applicants submit that the orthogonal configuration and disposition of the corner clip 32 into the web portions 29 does not allow any portion of the clip to move between a first position and a second position as recited in claim 1. Applicants further submit that at no time is the corner clip disposed within a window jamb assembly as recited in claim 1; rather, the bead 35 of the corner clip is disposed within the web portions 29 of a trim member 20. (Capoccia, FIGS. 3-5).

In view of the fact that not all elements and/or limitations of Applicants’ claim 1 can be found in Capoccia, Applicants respectfully request withdrawal of this basis of rejection of claim 1. Claims 2-7 are dependent on claim 1 and are patentable over Capoccia for the reasons stated above, in addition to the elements and/or limitations in such claims.

Claim 2:

In addition to the foregoing grounds set forth supporting the patentability of Applicants' claims 1-7 (of which claim 2 is included), Applicants cannot find (and the Office Action has failed to identify) in Capoccia an impact resistant window assembly "wherein the bracket portion is slidable from the first position to the second position," as recited in claim 2. To this end, Applicants hereby incorporate by reference the relevant arguments submitted above with respect to claim 1 (i.e., the orthogonal configuration and disposition of the corner clip 32 into the web portions 29 of the trim member 20 do not allow any portion of the clip to slide between a first position and a second position).

In view of the fact that not all elements and/or limitations of Applicants' claim 2 can be found in Capoccia, Applicants respectfully request withdrawal of this basis of rejection of claim 2.

Claim 3:

In addition to the foregoing grounds set forth supporting the patentability of Applicants' claims 1-7 (of which claim 3 is included), Applicants cannot find (and the Office Action has failed to identify) in Capoccia an impact resistant window assembly "wherein the bracket assembly is substantially concealed in the window jamb assembly when the bracket portion is disposed in the first position," as recited in claim 3. To this end, Applicants hereby incorporate by reference the relevant arguments submitted above with respect to claim 1 (i.e., at no time is the corner clip disposed within the window jamb assembly; rather, the bead 35 of the corner clip is disposed within the web portions 29 of the trim member 20).

In view of the fact that not all elements and/or limitations of Applicants' claim 3 can be found in Capoccia, Applicants respectfully request withdrawal of this basis of rejection of claim 3.

Claim 6:

In addition to the foregoing grounds set forth supporting the patentability of Applicants' claims 1-7 (of which claim 6 is included), Applicants cannot find (and the Office Action has failed to identify) in Capoccia an impact resistant window assembly "wherein the bracket

assembly further includes a filler disposed within the window jamb assembly,” as recited in claim 6. According to the Office Action, the trim member 20 of Capoccia comprises the claimed filler; however, the Office Action failed to identify in Capoccia a window jamb assembly and the filler being disposed within the window jamb assembly. Applicants again point out that Capoccia recites “[a] window 14 is disposed in the opening and supported in fixed relationship thereto by fastening a rigid peripheral frame 15 thereof to the studs 10 and horizontal frame members.” (Column 2, lines 34-37). On page 2, the Office Action stated the rigid peripheral frame 15 of Capoccia comprises the claimed window sash, thereby leaving only the studs 10 in Capoccia as the only possible option to assert as the window jamb assembly. It is evident from viewing FIG. 2 of Capoccia that the trim member 20 is not disposed within the stud 10.

In view of the fact that not all elements and/or limitations of Applicants’ claim 6 can be found in Capoccia, Applicants respectfully request withdrawal of this basis of rejection of claim 6.

Claims 8-13:

Applicants submit that not all of the elements and/or limitations of claims 8-13 can be found in the cited reference (Capoccia), as required by *W.L. Gore & Associates*, submit that the Office Action has failed to identify corresponding claim elements in Capoccia, as required by *Lindemann Maschinenfabrik GmbH*, and further submit that the Office Action is not interpreting the reference as would one of ordinary skill in the art, as required by *Scripps Clinic & Research Foundation*.

Claim 8:

Applicants cannot find (and the Office Action has failed to identify) in Capoccia, “a window including a window sash movably disposed within a window jamb assembly, the window further including a window jamb liner, the window sash having an exterior portion and an interior portion, the window sash slidable within a first plane of movement,” as recited in claim 8. To this end, Applicants hereby incorporate by reference the relevant arguments submitted above with respect to claim 1 (i.e., the window recited in Capoccia is of the fixed or non-opening type).

Applicants further cannot find (and the Office Action has further failed to identify) in Capoccia, “a bracket assembly disposed within the window jamb liner, the bracket assembly including a filler and a moveable bracket portion, the movable bracket portion having at least a first position and a second position, the bracket assembly providing reinforcement to the interior portion of the sash when the bracket portion is disposed in the second position, and the bracket assembly is at least partially concealed in the first position,” as further recited in claim 8. To this end, Applicants hereby incorporate by reference the relevant arguments submitted above with respect to claim 1 (i.e., the orthogonal configuration and disposition of the corner clip 32 into the web portions 29 does not allow any portion of the clip to move between a first position and a second position; at no time is the corner clip disposed within a window jamb assembly, rather, the bead 35 of the corner clip is disposed within the web portions 29 of a trim member 20).

Moreover, Applicants traverse the Office Action assertion that the trim member 20 and the corner clip 32 “provid[e] reinforcement to the interior portion of the sash” as recited in claim 1. Applicants submit that one of ordinary skill in the art would not interpret the subject matter of Capoccia as providing sash reinforcement. For instance, Capoccia recites “[e]ach trim member includes a facing web 21, a nailing flange 22 and a sealing web 23 . . . [t]he sealing web 23 is joined to the facing web 21 by a resiliently flexible web portion 29 . . . [m]aintenance of a sealing contact between the window frame 15 and the sealing web 23 is assured through the inherent resiliency of the material from which the trim member is formed.” (Column 2, lines 62-62; column 3, lines 30-32 and 54-57). In brief, it is submitted that the “resiliently flexible web portion 29” of Capoccia may provide sealing to the window, but does not provide “reinforcement” to the window sash as claimed by Applicants.

In view of the fact that not all elements and/or limitations of Applicants’ claim 8 can be found in Capoccia, Applicants respectfully request withdrawal of this basis of rejection of claim 8. Claims 9-13 are dependent on claim 8 and are patentable over Capoccia for the reasons stated above, in addition to the elements and/or limitations in such claims.

Claim 9:

In addition to the foregoing grounds set forth supporting the patentability of Applicants’ claims 8-13 (of which claim 9 is included), Applicants cannot find (and the Office Action has

failed to identify) in Capoccia an impact resistant window assembly “wherein the bracket assembly further includes a base plate coupled with an outer frame of the window,” as recited in claim 9.

In view of the fact that not all elements and/or limitations of Applicants’ claim 9 can be found in Capoccia, Applicants respectfully request withdrawal of this basis of rejection of claim 9.

Claim 10:

In addition to the foregoing grounds set forth supporting the patentability of Applicants’ claims 8-13 (of which claim 10 is included), Applicants cannot find in Capoccia an impact resistant window assembly “wherein the moveable bracket portion is disposed between the filler and a portion of a base plate,” as recited in claim 10.

In view of the fact that not all elements and/or limitations of Applicants’ claim 10 can be found in Capoccia, Applicants respectfully request withdrawal of this basis of rejection of claim 10.

Claim 11:

In addition to the foregoing grounds set forth supporting the patentability of Applicants’ claims 8-13 (of which claim 11 is included), Applicants cannot find in Capoccia an impact resistant window assembly “wherein the filler includes interlock features, the interlock features coupling a base plate and the movable bracket portion,” as recited in claim 11.

In view of the fact that not all elements and/or limitations of Applicants’ claim 11 can be found in Capoccia, Applicants respectfully request withdrawal of this basis of rejection of claim 11.

Claim 13:

In addition to the foregoing grounds set forth supporting the patentability of Applicants’ claims 8-13, Applicants cannot find (and the Office Action has failed to identify) in Capoccia an impact resistant window assembly “wherein the filler has an outer appearance similar to the jamb liner,” as recited in claim 13.

In view of the fact that not all elements and/or limitations of Applicants' claim 13 can be found in Capoccia, Applicants respectfully request withdrawal of this basis of rejection of claim 13.

Claims 23-26:

Applicants submit that not all of the elements and/or limitations of claims 23-26 can be found in the cited reference (Capoccia), as required by *W.L. Gore & Associates*, submit that the Office Action has failed to identify corresponding claim elements in Capoccia, as required by *Lindemann Maschinenfabrik GmbH*, and further submit that the Office Action is not interpreting the reference as would one of ordinary skill in the art, as required by *Scripps Clinic & Research Foundation*.

Claim 23:

Applicants cannot find (and the Office Action has failed to identify) in Capoccia, "a window including a window sash movably disposed within a window jamb assembly, the window further including a window jamb liner, the window sash having an exterior portion and an interior portion, the window sash slidable within a first plane of movement," as recited in claim 23. To this end, Applicants hereby incorporate by reference the relevant arguments submitted above with respect to claim 1 (i.e., the window recited in Capoccia is of the fixed or non-opening type).

Applicants further cannot find (and the Office Action has further failed to identify) in Capoccia, "a bracket assembly disposed within the window jamb liner; the bracket assembly including a filler and a moveable bracket portion, the moveable bracket portion having at least a first position and a second position, the bracket assembly providing reinforcement to the interior portion of the sash when the bracket portion is disposed in the second position, and a portion of the bracket assembly is disposed over a portion of the window sash when the bracket portion is disposed in the second position, and the bracket assembly is at least partially concealed in the first position where the bracket portion is recessed within the window jamb assembly in the first position," as further recited in claim 23. To this end, Applicants hereby incorporate by reference the relevant arguments submitted above with respect to claims 1 and 8 (i.e., the orthogonal

configuration and disposition of the corner clip 32 into the web portions 29 does not allow any portion of the clip to move between a first position and a second position; at no time is the corner clip disposed within a window jamb assembly, rather, the bead 35 of the corner clip is disposed within the web portions 29 of a trim member 20; and the resiliently flexible web portion 29 does not provide reinforcement to the window sash).

In view of the fact that not all elements and/or limitations of Applicants' claim 23 can be found in Capoccia, Applicants respectfully request withdrawal of this basis of rejection of claim 23. Claims 24-30 are dependent on claim 23 and are patentable over Capoccia for the reasons stated above, in addition to the elements and/or limitations in such claims.

Claim 24:

In addition to the foregoing grounds set forth supporting the patentability of Applicants' claims 23-30 (of which claim 24 is included), Applicants cannot find (and the Office Action has failed to identify) in Capoccia an impact resistant window assembly "wherein the bracket portion is slidable from the first position to the second position," as recited in claim 24. To this end, Applicants hereby incorporate by reference the relevant arguments submitted above with respect to claim 1 (i.e., the orthogonal configuration and disposition of the corner clip 32 into the web portions 29 of the trim member 20 do not allow any portion of the clip to slide between a first position and a second position).

In view of the fact that not all elements and/or limitations of Applicants' claim 24 can be found in Capoccia, Applicants respectfully request withdrawal of this basis of rejection of claim 24.

Claim 25:

In addition to the foregoing grounds set forth supporting the patentability of Applicants' claims 23-30 (of which claim 25 is included), Applicants cannot find (and the Office Action has failed to identify) in Capoccia an impact resistant window assembly "wherein the bracket assembly is substantially concealed in the window jamb assembly when the bracket portion is disposed in the first position," as recited in claim 25. To this end, Applicants hereby incorporate by reference the relevant arguments submitted above with respect to claim 1 (i.e., at no time is

the corner clip disposed within a window jamb assembly, rather, the bead portion 35 of the corner clip is disposed within the web portions 29 of a trim member 20).

In view of the fact that not all elements and/or limitations of Applicants' claim 25 can be found in Capoccia, Applicants respectfully request withdrawal of this basis of rejection of claim 25.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at (612) 359-3276 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

JEROME A. HAPKA ET AL.

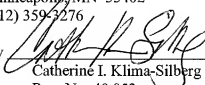
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